

REMARKS

Reconsideration and withdrawal of the rejections of the pending claims are respectfully requested in view of the amendments and remarks herein, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1-36 were pending in this application. Withdrawn claims 1-25, 30-32, 34 and 36 are cancelled. Withdrawn claim 35 has not been cancelled and Applicants request rejoinder of claim 35 as it depends from pending claim 26. Claims 26 and 33 are amended and claims 37-40 are added.

Claims 26 and 33 have been amended to delete particular moieties as suggested by the Examiner. Support for Ar recitation may be found on page 12 of the specification as originally filed. New claims 37-40 are added to recite thioamide derivatives of fipronil. Support may be found on page 83 of the specification as originally filed. No new matter has been added.

The Examiner is thanked for withdrawing the previous rejections under 35 U.S.C. § 112, second paragraph and 35 U.S.C. § 102.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. §112. It is submitted that the amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled. The issues raised by the Examiner in the Office Action are addressed below in the order they appear in the prior Action.

II. THE 35 U.S.C. §103 REJECTION IS OVERCOME

Claims 26-29 and 33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Alig et al.* in view of *Cleverly et al.* and *Stetter et al.*

The Examiner is respectfully directed to the case law, namely, that there must be some prior art teaching which would have provided the necessary incentive or motivation for modifying

the reference teachings. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowicz*, 27 U.S.P.Q. 2d 1063 (BOPAI 1993). Although a teaching, suggestion, or motivation to combine is no longer rigidly required for a finding of obviousness, it remains the primary guarantor against a non-statutory hindsight analysis. *Ortho-McNeil Pharm., Inc. v. Mylan Labs., Inc.*, 520 F.3d 1358, 1365 (Fed. Cir. 2008). Further, as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.” The requirement that For the §103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicant’s disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed.Cir. 1988).

Furthermore, the Supreme Court has recently reaffirmed the factors set out in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18: “[T]he scope and content of the prior art are determined; differences between the prior art and the claims at issue are...ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727.

Neither Alig *et al.* in view of Cleverly *et al.* and Stetter *et al.*, alone or in combination, teach or suggest a premix formulation comprising a compound of formula (II) and pharmaceutically acceptable wax, antioxidant and a pH modifier disclosed in claims 26 and 33 as amended.

The present invention is inventive as Applicants surprisingly discovered that blood plasma levels of fipronil was higher when dogs were administered the thioamide of fipronil than when fipronil was administered (see, e.g., Example 3 on page 85 of the specification as originally filed).

For the foregoing reasons, the references cited by the Examiner do not render the claimed subject matter *prima facie* obvious. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. §103(a) are respectfully requested.

III. THE DOUBLE PATENTING REJECTION IS OVERCOME

Claims 26-29 and 33 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1, 4, 5, 8-10, 13, 15-21, 23-29 and 33 or copending application no. 11/580,731.

The issue of whether there is indeed double patenting is contingent upon whether the remarks herewith are indeed considered and entered; and, if so, whether the Examiner believes there is overlap with claims ultimately allowed in the application. If, upon agreement as to allowable subject matter, it is believed that there is still a double patenting issue, a Terminal Disclaimer as to U.S. patent application no. 11/580,731 will be filed for the purposes of expediting prosecution.

Accordingly, reconsideration and withdrawal of the double patenting rejection, or at least holding it in abeyance until agreement is reached as to allowable subject matter, is respectfully requested.